

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Matthew C. Heidner; Thomas Holman
Application No.:	10/066994
Filed:	February 4, 2002
For:	Non-Removable Bonding Sleeve and Product Component
Examiner:	Vy Q. Bui
Group Art Unit:	3773

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2B-9090-US01

BRIEF ON APPEAL

This is an Appeal Brief for the above-identified Application in which claims 61, 63-65, 67, 69-73 and 88 were rejected in the Final Office Action mailed July 14, 2009. A Notice of Appeal was filed in this case on August 20, 2009. This brief is submitted in accordance with 37 CFR, § 41.37. The fees required under 37 CFR § 41.20(b)(2), and any petition for an extension of time required for filing this brief, are addressed in the accompanying Transmittal Letter.

A Table of Contents is included on page 2 of this document.

TABLE OF CONTENTS

Identification Page.....	cover page
(i) Real Party in Interest	3
(ii) Related Appeals and Interferences	4
(iii) Status of Claims.....	5
(iv) Status of Amendments	6
(v) Summary of Claimed Subject Matter.....	7
(vi) Grounds of Rejection to be Reviewed on Appeal	9
(vii) Argument	
Issue 1.....	10
Discussion of Independent claim 61	10
Discussion of Dependent claim 64	20
Discussion of Dependent claim 65	21
Discussion of Dependent claim 73	22
Issue 2.....	22
Discussion of Dependent claim 67	22
(viii) Claims Appendix.....	24
(ix) Evidence Appendix	25
(x) Related Proceedings Appendix.....	26

- (i) Real Party in Interest

The Application is assigned to Boston Scientific Scimed, Inc., One Scimed Place, Maple Grove, Minnesota 55311-1566, a Minnesota corporation and a subsidiary of Boston Scientific Corporation, One Boston Scientific Place, Natick, Massachusetts 01760-1537, a Delaware Corporation.

(ii) Related Appeals and Interferences

No related appeals or interferences are pending.

(iii) Status of Claims

Claims 45-61, 63-67, 69-73 and 75-88 are pending in the present application.

Claims 61, 63-65, 67, 69-73 and 88 have been finally rejected and are the subject of the present Appeal. Claims 1-44, 62, 68, and 74 have been canceled and claims 45-60, 66 and 75-87 have been withdrawn.

(iv) Status of Amendments

There was no response to the Final Office Action other than a Notice of Appeal, which was filed on August 20, 2009, and thus there were no amendments after the Final Office Action. The claims remain as they were prior to the issuance of the Final Action on July 14, 2009, as shown in Applicants response submitted on March 25, 2009.

(v) Summary of Claimed Subject Matter

A summary of representative claims and a non-limiting listing of locations where support may be found [bracketed citations] and reference numerals is provided as follows:

Independent claim 61 recites a catheter [page 5, lines 5-6] comprising a distal shaft [page 8, line 29; figs. 7, item 74; claim 18 as filed] having a length, a substantially constant outer diameter along a majority of its length, a lumen [claim 18 as filed] and a proximal end [page 9, lines 3-4; figure 7, item 80; claim 18 as filed]. The catheter further includes a proximal shaft [figure 7, item 72] having a length, a substantially constant outer diameter along a majority of its length, a wall defining an inner lumen and a distal end [page 9, line 3; figure 7, item 82]. The distal end [figure 7, item 82] of the proximal shaft [figure 7, item 72] is connected to [page 9, lines 3-5 and 9-11] the proximal end [figure 7, item 80] of the distal shaft [figure 7, item 74] and the lumens of the respective shafts are in fluid communication with one another [figure 7; claim 18 as filed].

The catheter also includes a heat shrinkable sleeve [page 8, line 28; figure 7, item 84] overlapping [figure 7; claim 18 as filed] the proximal end of the distal shaft and the distal end of the proximal shaft, providing a water seal [page 8, lines 28-29]. The heat shrinkable sleeve [figure 7, item 84] extends distally beyond the proximal shaft [figure 7, items 72, 82, 84].

The catheter further includes a port [page 8, lines 31-33; figure 7, item 78], wherein the port [figure 7, item 78] is positioned between the first and second ends of the heat shrinkable sleeve [figure 7, items 84, 78] and is formed at least partially transversely through the wall of the proximal shaft [page 9, lines 5-6; figure 7, items 72, 82, 78]. The catheter is sterilized and prepared to safely enter a body [claim 18 as filed].

Dependent claim 64 recites that the heat shrinkable sleeve comprises a thermoplastic polymer which is substantially not cross-linked [page 5, lines 27-28; claim 21 as filed].

Dependent claim 65 recites that the heat shrinkable sleeve is gradually heat shrunk along its length around the distal shaft and proximal shaft [page 2, line 33 to page 3, line 2; page

6, lines 14-19; claim 22 as filed].

Dependent claim 67 recites that the proximal shaft is metal [claim 24 as filed].

Dependent claim 73 recites that the distal shaft and the proximal shaft abut each other [page 9, lines 10-15; claim 30 as filed].

(vi) Grounds of Rejection to be Reviewed on Appeal

Issue 1: Whether the Examiner erred in rejecting claims 61, 63-65, 69-73 and 88 under 35 USC §102(c) as being anticipated by or, in the alternative, under 35 USC §103(a) as being obvious over Holman et al. (US 6837897).

Issue 2: Whether the Examiner erred in rejecting claim 67 under 35 USC §103(a) as being unpatentable over Holman et al. (US 6837897).

(vii) Argument

Issue 1:

The Office Action rejected claims 61, 63-65, 69-73, 88 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holman et al. (US 6837897). A full account of the rejection is found on pages 2-4 of the Final Office Action. This rejection is traversed.

The rejection is based on §102 or, in the alternative, §103. However, as pointed out in Applicant's response filed August 2, 2005, under §103(c), Holman et al. can not be used as prior art for the purpose of a §103 rejection. Therefore, the 103 rejection is inappropriate. Acknowledgment of this point in any forthcoming Examiner's Answer is requested. As such, Applicant herein only addresses what appears to be the §102 portion of the present rejection.

It is also of note that Holman et al. was previously used in a rejection of the present claims in the Office Action dated January 3, 2006, but the rejection was overcome.

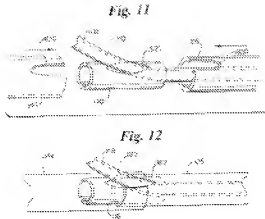
Independent claim 61:

Independent claim 61, directed to a catheter, includes the following recitation:
a heat shrinkable sleeve overlapping the proximal end of the distal shaft and the distal end of the proximal shaft providing a water seal, wherein the heat shrinkable sleeve extends distally beyond the proximal shaft

This recitation is not taught or suggested by Holman.

The Final Office Action maintains that Figs. 11 and 12 of Holman, reproduced below, disclose all of the features of the rejected claims. Specifically, the Final Office Action calls out the following features of Holman and asserts they correspond to specific features, as noted below, in claim 61 (terms used below are from the rejection):

- reference numeral 144 *corresponds to* "heat shrinkable sleeve" in claim 61;
- reference numeral 116 *corresponds to* "distal shaft" in claim 61;
- reference numeral 105 (col. 8, lines 15-51) *corresponds to* "proximal shaft" in claim 61; and
- cut 162a (through proximal shaft 105), cut 162b (through heat shrinkable sleeve 144) and cut 162c (through distal shaft 116) communicating with an inner shaft 108 may be for receiving a guide wire substantially as recited in the claims *corresponds to* "port" in claim 61.



To that end, the Final Office Action asserts:

Note that a proximal and distal directions can be chosen by an observer to match the language in the claims as indicated in above reproduced Fig. 11.

This is wrong and the rejection fails at least because:

- A. Examiner applies inappropriate definitions to the terms distal and proximal in interpreting figures from the cited art making the rejection improper;
- B. The noted figures in the cited reference, when appropriately interpreted, fail to anticipate the claimed invention;
- C. Examiner does not provide for or sufficiently establish in the cited reference a 'heat shrinkable sleeve' and has misinterpreted the term 'heat shrink' in claim 61; and
- D. Even using the rejection's inappropriate interpretation of the cited figures, the rejection fails to account for each and every element of the claimed invention and anticipation is still not shown.

A.

The rejection fails at least because Examiner applies inappropriate definitions to the terms “distal” and “proximal” in interpreting figures 11-12 of the cited reference. When looking at the cited figures in a manner which is appropriate to one skilled in the art, it is clear that the cited figures do not anticipate the invention of noted claims.

In using the device of figures 11-12 of Holman et al. for anticipatory reasons against claim 61, the rejection improperly has identified the *distal* outer shaft 105 in figures 11-12 as a “*proximal* shaft”, the tubular support member 116 as a “distal shaft”, and the midshaft tube 144 as a “heat shrinkable sleeve”. In doing so, the rejection has not only misapplied terms from claim 61, it has reversed the meanings of the terms “proximal” and “distal” as they are established in both Applicant’s Specification and the cited reference, Holman et al., as well as in the understanding of the skilled in the art of catheter design.

These improper identifications of elements are inconsistent with Applicant’s disclosure and the reasonable understanding of one skilled in the art, which are required considerations in the prosecution of claims. As is stated:

"PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997),

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

and

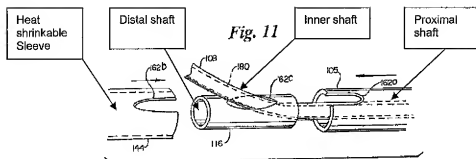
MPEP 2111

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim

language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

The rejection, in an attempt to read figures 11-12 of Holman et al. onto the elements of claim 61, has taken figures 11-12 of Holman et al. and has wrongly switched around the understood terms for elements of the device and reversed the understood relative positions of "proximal" and "distal". To illustrate this, the rejection uses the following marked-up figure 11.



In the representation, the rejection calls the *distal* outer shaft 105 the "*proximal* shaft". This is opposite to the designation that one skilled in the art would apply to it. The rejection calls the tubular support member 116 the "*distal* shaft", even though it is proximal to the assigned "*proximal* shaft" and is contrary to Holman et al. already designating item 105 as the "*distal* outer shaft." Finally, the midshaft tube 144 is called the "*heat shrinkable sleeve*" in the rejection, even though it is the proximal shaft among the three elements above and there is no indication that it is a "*heat shrinkable sleeve*" consistent with Applicant's disclosure or with the understanding of one skilled in the art.

The rejection contradicts the use of the terms proximal and distal in both Applicant's Specification and Holman et al.'s disclosure. When dealing with and discussing catheters, the terms proximal and distal have meaning that allows ones skilled in the art to understand how the catheter is constructed and works. The conditions and workings of the distal end of the catheter are much different than the proximal end. The distal end is inserted into the body, with the conditions that entails, and is designed to perform a certain function at a target location within the body. The proximal end remains outside of the body and includes manipulative tools at the manifold (102 below) for the user to control the catheter's use.

Figure 1 (shown below) of Holman et al. shows an example of such a catheter.

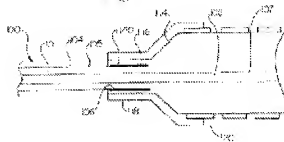
Fig. 1



In describing Fig. 1, Holman et al., states "Catheter assembly 101 comprises a manifold 102 at the proximal end...". In the same paragraph, item 107, identified as a medical device receiving region, and shown in Figure 2, reproduced below, is described as follows:

FIG. 2 is a longitudinal cross-sectional view of a portion of the *distal* end of a medical device delivery system with parts cut away. (emphasis added)

Fig. 2



In light of this description, one of ordinary skill in the art would understand the terms proximal and distal in general and, in particular, that the distal end of the catheter with the balloon is the end which enters the body first. Applicant notes that, in describing figures 11-12, Holman et al. identifies item 105 as "distal outer tube". (Col. 8, line 19)

When the device of figures 11-12 of Holman et al. (shown below and referenced in the Final Office Action) is viewed from a perspective that is consistent with the Holman specification and with the interpretation that those skilled in the art would reach after reviewing Holman et al. and Applicant's Specification, one sees that the interpretation in the rejection using the above marked up figure 11 is reversed.

Fig. 11

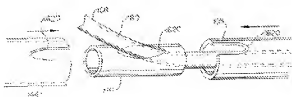
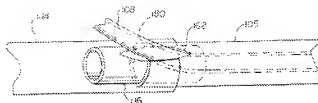


Fig. 12



In describing the above figure, the Holman et al. disclosure states at column 8, lines 19-37:

In accordance with the method, *distal outer tube 105* having a notch 162a therein at the *proximal end* is provided as is *midshaft tube 144*...Midshaft tube 144 has a notch 162b therein at the distal end. When midshaft tube 144 and distal outer tube 105 are assembled, notches 162a and 162b are aligned to form guidewire *port 162*. *Tubular support member 116* having an opening 162c therein is also provided. Inner tube 108 enters tubular support member 116 through opening 162c and extends through the distal end of the tubular support member and into distal outer tube 105. Support for inner tube 108 is provided by support mandrel 180. As shown in FIG. 12, midshaft tube 144 and distal outer tube 105 are brought together with notches 162a and 162b aligned to form guidewire port 162 through which inner tube 108 with support mandrel 180 therein enters the assembly. Midshaft tube 144 and distal outer tube 105 *overlap* on support member 116. (*Emphasis mine*)

The uses of the terms “proximal” and “distal” make it clear that the right side of the figure showing the *distal* outer tube 105 is the distal end of the catheter portion shown and the left side of the figure is the proximal end of the catheter portion shown. The rejection’s interpretation is the reverse of this.

The use of these terms, proximal and distal, indicates something about the particular catheter element and its position relative to other elements of the catheter and in some cases its effect on other elements because of its relative distal or proximal positioning relative to those elements. Terms that are part of names of elements that indicate relative positioning can not just be ignored, especially when the cited reference uses the claimed terms in substantially the same way.

As such, the rejection improperly reverses the meanings and use of the terms “proximal” and “distal” and should therefore be overturned.

B.

The rejection further fails, because, the noted figures 11-12 in the cited reference, when appropriately interpreted, fail to anticipate the claimed invention.

When Figs 11-12 of Holman et al. are viewed using a proper interpretation of the terms proximal and distal, it is clear that the Holman device of Figs. 11-12 does not have “a *heat shrinkable sleeve* (84) *overlapping* the proximal end (80) of the distal shaft (74) and the distal end (82) of the proximal shaft (72)” (reference numerals referring to figure 7 shown above), as required by claim 61.

The device of figures 11-12 of Holman et al., as described above in the excerpt from Holman et al., includes a distal outer tube 105, a midshaft tube 144 proximal to the distal outer tube 105, and a tubular support member 116. As stated in the last line of the excerpt above and as is clearly shown in figure 12, the “[m]idshaft tube 144 and the distal outer tube 105 *overlap on* support member 116.” The support member 116, which also has not been established to be a “heat shrinkable sleeve”, is *within* the distal outer tube 105 and the midshaft tube 144 and *does not overlap* the proximal end thereof and the distal end thereof, respectfully, as required by claim 61 and shown in figure 7.

An appropriate interpretation shows the device of figures 11-12 of Holman et al. is clearly different from the device claimed in claim 61 and does not anticipate the claimed invention. As such, the rejection fails and should be overturned.

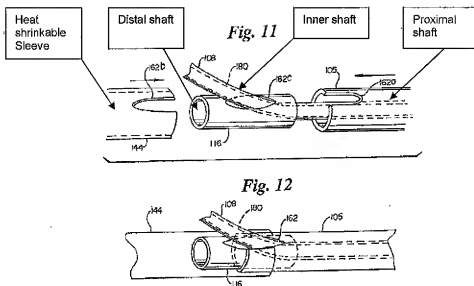
C.

The rejection further fails because it does not provide for or sufficiently establish in the cited reference a heat shrinkable sleeve and has misinterpreted the term 'heat shrink' as claimed in claim 61.

Considering the cited figures 11-12 discussed above and the claim language of claim 61, it can not be said that the above figures show “a heat shrinkable sleeve overlapping the proximal end (the left end) of the distal shaft (distal outer tube 105) and the distal end (the right end) of the proximal shaft (reasonably corresponding to midshaft tube 144)” as required by claim 61. The support member 116 has not been established as a “heat shrinkable sleeve” as is used in Applicant's Specification or as is understood by one skilled in the art. Even if support member

116 were seen as a ‘heat shrinkable sleeve’, it is within the distal outer tube 105 and midshaft 144 and does not “overlap” the ends thereof, as required by claim 61. Instead, as mentioned above, “midshaft tube 144 and distal outer tube 105 overlap on [the] support member 116.” (Column 8, lines 36-37).

Even improperly interpreting the claim language of claim 61 and improperly applying it to figures 11-12 as is done in the rejection, the rejection fails to sufficiently establish a ‘heat shrinkable sleeve’ as claimed. The rejection uses the following characterization of figures 11-12:



The rejection labels the distal outer shaft 105 in figures 11-12 as the “proximal shaft”, the tubular support member 116 as a “distal shaft”, and the midshaft tube 144 as a “heat shrinkable sleeve”.

The rejection fails at least because the midshaft tube 144 has not been established as a “heat shrinkable sleeve” as is used in Applicant’s Specification or as is understood by one skilled in the art. As explained in Applicant’s Specification at page 2, line 31, to page 3, line 2, among other places, “[i]nitially, the sleeve is positioned over and around the catheter parts to be bonded together or to be encapsulated. *A heating unit is used to apply heat to the sleeve to shrink it on the catheter.* Heat, or any other method used to shrink the sleeve, is applied to one spot and then gradually moved along the length of the sleeve, gradually removing air and space between the sleeve and the catheter parts.” (Emphasis added) As such, the material of a heat shrinkable sleeve shrinks upon the application of heat such that the sleeve itself shrinks and grips the item it

is positioned around.

It is asserted in the rejection on page 3 of the Office Action “that sleeve 144 is heat shrinkable because sleeve 144 will shrink when the temperature is reduced....” However, reducing the temperature of something doesn’t show that it is *heat* shrinkable. To the contrary, material that shrinks upon cooling would likely expand upon heating – the opposite of heat shrinkable material. The assertion also doesn’t address whether the material of the midshaft 144 does such a thing.

It is further asserted in the rejection on page 3 of the Office Action that “[a]lternatively, sleeve 144 is heat shrinkable because when the sleeve 144 will shrink from [a] melting condition to a stable condition at a room temperature to secure sleeve 144 to proximal shaft 105 (col. 8, lines 36-40).” However, col. 8, lines 36-40 does not state that the midshaft 144 shrinks under the application of heat. It addresses welding via radiation the outer tube 105 to the midshaft tube 144. Melting does not mean shrinking. Shafts are typically extruded and close to amorphous conditions and therefore are not really heat shrinkable sleeves. The melting, changing from a solid to a liquid or dissolving is not shrinking a sleeve under heat. Different materials react differently under heat.

As such, the rejection fails at least because it fails to sufficiently provide for a ‘heat shrinkable sleeve’ and the cited midshaft tube 144 has not been established as a “heat shrinkable sleeve” as is used in Applicant’s Specification or as is understood by one skilled in the art.

D.

Even improperly interpreting the claim language of claim 61 and improperly applying it to figures 11-12 as is done in the rejection, the rejection still fails to provide for each and every element of the claimed invention. As shown above, the rejection uses the following characterization of figures 11-12:

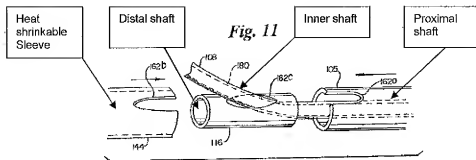


Fig. 11

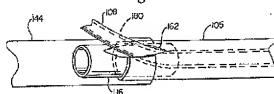
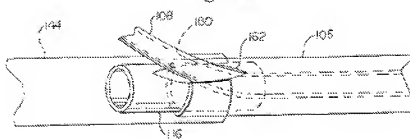


Fig. 12

The rejection labels the distal outer shaft 105 in figures 11-12 as the “proximal shaft”, the tubular support member 116 as a “distal shaft”, and the midshaft tube 144 as a “heat shrinkable sleeve”.

The rejection further fails even under its improper characterizations because the designated “heat shrinkable sleeve” (midshaft 144), does not overlap the proximal end (the right end due to the reversal of proximal and distal) of the designated “distal shaft” (tubular support member 116), as required by claim 61. Rather, as shown in figure 12 below, the midshaft 144 (designated to be the heat shrinkable sleeve) ends before it reaches the “proximal end” (the right end in figure 12) of the support member 116 (designated as the distal shaft) and thus doesn’t overlap the “proximal end” (right end) of the designated “distal shaft”.

Fig. 12



The rejection also fails under its improper characterizations because the port 162 is not positioned *between* the first and second ends of the designated heat shrinkable sleeve (midshaft 144), as is required by claim 61. As seen above, the port 162 transversely extends

beyond the end (right end) of the midshaft 144 and is not *between* the ends of the midshaft 144.

As shown above, not only does the rejection fail under a proper characterization of the device shown in figures 11-12 of Holman et al. to anticipate claim 61, it also fails under the improper characterization of the figures asserted in the rejection to show each and every element of the claim 61.

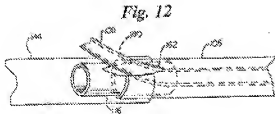
--

As clearly shown, the rejection fails at least because: *A.* Examiner applies inappropriate definitions to the terms distal and proximal in interpreting figures from the cited art; *B.* The noted figures in the cited reference, when appropriately interpreted, fail to anticipate the claimed invention; *C.* Examiner does not provide for or sufficiently establish in the cited reference a 'heat shrinkable sleeve' and has misinterpreted the term 'heat shrink' in claim 61; and *D.* Even using the rejection's inappropriate interpretation of the cited figures, anticipation is still not shown. As such, it is respectfully requested that the rejection be overturned.

As to the remaining comments in the rejection that lend themselves to the alternative §103 portion of the rejection, it is once again noted by Applicant that Holman et al. is not proper prior art for a §103 rejection. Therefore the assertions in the rejection that are assertions of obviousness are improper.

Dependent Claim 64:

In addition to the reasons stated above in regard to claim 61, upon which claim 64 is dependent, claim 64 is further not anticipated at least due to the following.



Dependent claim 64 requires that "the heat shrinkable sleeve comprises a thermoplastic polymer which is substantially not cross-linked." In addressing claim 64, the

rejection asserts that “[a]s to claim 64, inherently heat shrinkable sleeve 144 is a polymer of lower melting temperature than that of distal shaft 116 of a higher melting temperature to avoid damage to shaft 116 when sleeve 144 is welded to shaft 105.” However, the inherency alleged in the rejection has not been established by the rejection. The assertion of inherency requires clarity for purposes of an anticipation rejection. As is stated:

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Moreover, this assertion does not show that Holman et al. teaches that “the heat shrinkable sleeve (designated to be midshaft 144) comprises a thermoplastic polymer which is substantially not cross-linked.”

As such, the rejection’s assertion is unclear and it does not support an anticipation rejection. It is respectfully requested that the rejection be overturned.

In addressing claim 64, the rejection further states that “[a]lternatively, it would have been *obvious* to one of ordinary skill in the art to make sleeve 144 from a polymer as polymer material is well known material for its flexibility and suitable for making a catheter for deployment in a tortuous lumen in a body.” Since this assertion deals with obviousness and appears to be part of the alternative §103 part of the rejection, it is not addressed herein because, as mentioned above, using Holman et al. in a §103 rejection is improper.

Dependent Claim 65:

In addition to the reasons stated above in regard to claim 61, upon which claim 65 is dependent, claim 65 is further not anticipated at least due to the following.

Dependent claim 65 requires “the heat shrinkable sleeve being gradually heat shrunk along its length around the distal shaft and proximal shaft.” The rejection further fails at least because the rejection does not address this feature at all and it is not apparent in Holman et al that it is taught. The rejection provides no indication that the midshaft 144 (designated to be the

heat shrinkable sleeve) is “gradually heat shrunk along its length around the distal shaft (support member 116) and proximal shaft (distal outer tube 105)”, as required by claim 65. As such, it is respectfully requested that the rejection be overturned.

Dependent Claim 73:

In addition to the reasons stated above in regard to claim 61, upon which claim 73 is dependent, claim 73 is further not anticipated at least due to the following.

Dependent claim 73 requires that “the distal shaft and the proximal shaft abut each other.” It is asserted in the rejection that “[a]s to claim 73, distal shaft 116 and proximal shaft 105 abut circumferentially one to another. However, as is clearly shown above in figure 12 of Holman et al., support member 116 and distal outer tube 105 do not abut one another, rather they overlap. The use of the term “abut” in the assertion of the rejection is inconsistent with the use in Applicant’s application. In Applicant’s Application, the term “abut” is clearly used as an alternative to overlap. The rejection is essentially giving the terms the same meaning. This is improper and it is respectfully requested that the rejection be overturned.

At least for these the reasons stated above, the asserted cited reference does not anticipate claims 61, 63-65, 69-73 and 88. As such, it is asserted by Applicant that the rejection fails and it is respectfully requested that the rejection be overturned.

Issue 2:

The Office Action rejected claim 67 under 35 U.S.C. 103(a) as being obvious over Holman et al. (US 6837897). A full account of the rejection is found on pages 3-4 of the Final Office Action. This rejection is traversed.

The rejection fails at least because, as pointed out in Applicant’s response filed August 2, 2005, under §103(c), Holman et al. can not be used as prior art for the purpose of a §103 rejection. The rejected claimed invention of the present application and Holman et al. (US 6837897) were owned by the same entity or subject to an obligation of assignment to the same

entity at the time of invention. Acknowledgment of this point in any forthcoming Examiner's Answer is requested. As such, the rejection fails and it is respectfully requested that the rejection be overturned.

Argument Conclusion

Based on at least the foregoing arguments, Applicant respectfully asserts that the rejections presented by the Examiner fail to establish anticipation and/or obviousness of the rejected claims. Accordingly, Applicant respectfully requests that the Board reverse all of the Examiner's rejections.

Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS

Date: October 20, 2009

By: /Jonathan Grad/
Jonathan Grad
Registration No. 41795

6640 Shady Oak Dr., Suite 400
Eden Prairie, MN 55344-7834
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

(viii) Claims Appendix

61. A catheter comprising: a distal shaft having a length, a substantially constant outer diameter along a majority of its length, a lumen and a proximal end; a proximal shaft having a length, a substantially constant outer diameter along a majority of its length, a wall defining an inner lumen and a distal end, the distal end of the proximal shaft being connected to the proximal end of the distal shaft and the lumens of the respective shafts being in fluid communication with one another; a heat shrinkable sleeve overlapping the proximal end of the distal shaft and the distal end of the proximal shaft providing a water seal, wherein the heat shrinkable sleeve extends distally beyond the proximal shaft; and a port, wherein the port is positioned between the first and second ends of the heat shrinkable sleeve and formed at least partially transversely through the wall of the proximal shaft, wherein the catheter is sterilized and prepared to safely enter a body.
63. The catheter of claim 61, wherein the distal shaft and the proximal shaft overlap.
64. The catheter of claim 61, wherein the heat shrinkable sleeve comprises a thermoplastic polymer which is substantially not cross-linked.
65. The catheter of claim 61, the heat shrinkable sleeve being gradually heat shrunk along its length around the distal shaft and proximal shaft.
67. The catheter of claim 61, wherein the proximal shaft is metal.
69. The catheter of claim 61, further comprising an inner shaft within the distal shaft, wherein the inner shaft is in communication with the port.
70. The catheter of claim 61, wherein the port is formed in the proximal shaft.
71. The catheter of claim 61, wherein the port is at least partially formed in the distal shaft.
72. The catheter of claim 61, wherein the port is formed in the distal shaft and the proximal shaft.
73. The catheter of claim 61, wherein the distal shaft and the proximal shaft abut each other.
88. The catheter of claim 69, wherein the inner shaft is a guide wire shaft, through which a guide wire may be used.

(ix) Evidence Appendix

None

(x) Related Proceedings Appendix

None